## REMARKS

Claims 1-6, 9, 10, 13-20 and 22-25 are pending in the present application, as newly added or amended in this amendment. Claims 7-8, 11-12 and 21 have been cancelled. Claims 1 and 4 are the only independent claims.

In the Office Action, claims 4-6, 9, 10, 13 and 20 were rejected under 35 U.S.C. Section 112, first paragraph. Claims 1, 16, 18 and 19 were rejected under 35 U.S.C. Section 102(b) as being anticipated by U.S. Patent No. 5,403,312 to Yates et al. Claims 1, 14-19 and 21 were rejected under 35 U.S.C. Section 102(e) as being anticipated by U.S. Patent No. 6,699,240 to Francischelli. Claim 21 was rejected under 35 U.S.C. Section 102(b) as being anticipated by U.S. Patent No. 6,096,037 to Mulier et al. Also, claims 2 and 3 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Yates or Francischelli and/or in further view of U.S. Patent No. 5,680,860 to Imran. In addition, claims 1-3, 13-19 and 21 were rejected based on obviousness-type double patenting over claims 1-11 of U.S. Patent No. 6,517,536 in view of Yates or Francischelli and/or in further view of Mulier.

Applicants respectfully submit that the pending claims, as amended, are allowable. Reconsideration and allowance are respectfully requested for the reasons stated below.

Amended independent claim 1 is generally directed to a device for clamping and ablating cardiac tissue. The device comprises, inter alia, first and second opposed jaws movable between a first open position and a second clamped position. Also, claim 1 includes first and second electrical conductive members carried by the respective first and second jaws. Claim 1 further includes at least one jaw including a surface for

engaging tissue clamped between the jaws. Such surface comprises insulative material and an aperture extends through the insulative material. The respective conductive member of such jaw is carried at least in part in the jaw and is conductive of electrical energy through the aperture to tissue clamped between the jaws. As further recited in amended claim 1, such conductive member has a width within the jaw greater than the width of the aperture and includes a solid, electrically conductive surface for engaging cardiac tissue clamped between the jaws. By "solid," applicant means an electrode arrangement such as the type shown, for example, in Figures 3, 6 and 28-32, which do not include apertures or interruptions in the tissue engaging surface for passage of water or other conductive liquids as shown, for example, in Mulier.

Amended independent claim 4 is generally directed to a tissue grasping apparatus comprising first and second grasping jaws which are relatively movable between open and closed positions. In claim 4, each jaw includes an electrode and a clamping surface in opposed relation with the electrode and clamping surface of the other jaw. Claim 4 also includes that the clamping surfaces of the jaws comprise an insulating material defining an elongated aperture having a width. As further recited in claim 4, at least one of the opposed electrodes is carried at least in part within the jaw. Such electrode has a width within the jaw greater than the width of the elongated aperture and also includes a solid, electrically conductive surface for engaging cardiac tissue clamped between the jaws. Such electrode is connectable to a power source for providing an electrical current through tissue clamped between the electrodes.

**Independent Claim 1 And The Respective Dependent Claims Are Not Anticipated Or Obvious In View of Yates**

The Examiner has relied upon the cutting and stapling device disclosed at Fig. 13 of Yates to reject claim 1. However, such structure, or any other structure disclosed in Yates, does not teach or suggest the features of amended claim 1.

In Fig. 13 of Yates, the cutting and stapling instrument includes an upper jaw 334 with a U-shaped insulator 355a that surrounds a U-shaped first electrode 352. The first electrode 352 in Fig. 13 of Yates clearly does not have a width within the jaw 334 that is greater than the width of the aperture extending through the U-shaped insulator 355A, in contrast to claim 1.

In Fig. 13 of Yates, a lower jaw 332 also does not teach or suggest the claimed features. A second electrode (labeled as 332 in Fig. 13) actually forms the lower jaw structure including the outer surface thereof and, thus, is not carried by the jaw 332, in contrast to claim 1.

Also in contrast to claim 1, the lower jaw/electrode 332 in Fig. 13 of Yates does not have a width within the jaw 332 greater than the width of the channel 342. The electrode in Fig. 13 of Yates forms the jaw itself and, accordingly, cannot define a width within such jaw 332. Thus, Yates does not teach or suggest the claimed invention for these reasons.

Further, Yates does not teach or suggest the claimed invention for another reason. The lower jaw/electrode 332 in Fig. 13 of Yates is insulated from a knife channel 342 formed therein by a U-shaped insulator 355b. Thus, such jaw/electrode

332 is clearly not carried at least part in the jaw to be conductive of electrical energy through such channel, in contrast to claim 1.

It would not be obvious to modify Yates in the absence of applicant's disclosure because Yates teaches an opposed structure that actually teaches away from the subject matter of claim 1. Yates teaches a coagulation, cauterization, and/or tissue welding device to "simultaneously cauterize or weld a relatively larger area or length of tissue than in previously known devices." (Column 2, lines 31-33 and 36-38) (emphasis added). Yates teaches that if the electrodes are disposed on opposite jaws, they "are offset from each other so that they are not diametrically opposed from each other on interfacing surfaces" so as to enable the current path between the electrodes to weld relative wide areas of tissue (column 2, lines 55-57; column 3, lines 13-16) (emphasis added). Yates expressly teaches a wide treatment zone that teaches away from any narrowing aspect relative to the electrode and/or energy conducted by such electrode to tissue clamped between the jaws, in contrast to claim 1.

For all the above reasons, the claims would not have been obvious and are respectfully believed to be allowable.

**Independent Claim 1 And The Respective Dependent Claims Are Not Anticipated Or Obvious In View Of Francischelli**

Although Francischelli is relied upon as a prior art to reject claim 1, it is respectfully submitted that Francischelli is not prior art. The subject matter of claim 1 was disclosed prior to Francischelli's earliest effective filing date.

Francischelli was filed December 12, 2001, and claims priority to U.S. Provisional Application No. 60/286,953, filed April 26, 2001. However, the subject matter of claim 1

was disclosed in U.S. Patent No. 6,546,935, filed December 22, 2000, and in U.S. Provisional Application No. 60/200,072, filed April 27, 2000, which applications are relied upon for priority in the present application. Accordingly, Francischelli is not prior art to the present invention, and the rejection of claim 1 based on Francischelli should be withdrawn.

In any event, Francischelli also does not describe or suggest the presently claimed subject matter for reasons such as discussed above, including a solid tissue contacting surface.

**Independent Claim 4 And Its Respective Dependent Claims Complies with Section 112, First Paragraph**

In response to the Office Action, it is noted that the subject matter of claims 4-6, 9, 10, 13 and 20 complies with Section 112, first paragraph. The subject matter was described and shown in the specification, for example, at paragraph 97 and in Fig. 6 of the published application, which shows an electrode 16 having a width within a jaw that includes an insulator 18. The width of the electrode 16 within the jaw is greater than the width of the elongated aperture defined in the jaw (i.e., the opening through which the electrode extends outwardly from the jaw).

Accordingly, withdrawal of this rejection and allowance of claim 4 is respectfully requested.

**The Double Patenting Rejections Should Also Be Withdrawn**

Based on the above discussion, the cited references do not teach or suggest the claimed subject matter such that any combination of these references with U.S. Patent No. 6,517,536 also cannot teach or suggest the claimed subject matter.

Accordingly, it is respectfully requested that the obviousness-type double patenting rejections based on claims 1-11 of U.S. Patent No. 6,517,536 in combination with the cited reference be withdrawn for similar reasons as discussed above.

## Conclusion

For all the above reasons, reconsideration or withdrawal of the claim rejections are respectfully requested.

Respectfully submitted,

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